

A proper *prima facie* case of obviousness requires that the cited references when combined must “teach or suggest all the claim limitations,” and that there be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references or to modify the reference teachings. See Manual of Patent Examining Procedure (MPEP), Eighth Edition, August 2001, §706.02(j).

Applicants submit that the Examiner has failed to establish a proper *prima facie* case of obviousness in the present §103(a) rejection, in that the Mortensen and Weber references, even if assumed to be combinable, fail to teach or suggest all the claim limitations, and in that no cogent motivation has been identified for combining the references or for modifying the reference teachings to reach the claimed invention. Further, even if it is assumed that a proper *prima facie* case has been established, there are particular teachings in one or more of the references which controvert the obviousness argument put forth by the Examiner.

Independent claim 1 is directed to a network management system comprising an inter-domain configuration manager arranged between a set of one or more network service management applications and a plurality of network element domain managers, each of the domain managers being associated with a particular architectural or technological domain of a multi-layer network, the configuration manager implementing network service design and provisioning functions across a plurality of the domains of the network in conjunction with stored connectivity information characterizing the multi-layer network. The claim further specifies that the inter-domain configuration manager comprises an inter-domain tree manager, with the inter-domain tree manager comprising a logical tree manager. The logical tree manager is operative to manage a transport service and facility hierarchy associated with the multi-layer network, and to maintain corresponding parent-child relationships in one or more tree structures that reference the domains containing real-time network details associated with the transport service and facility hierarchy.

The Examiner in formulating the §103(a) rejection of claim 1 acknowledges that the Mortensen reference fails to teach or suggest an inter-domain tree manager comprising a logical tree manager as claimed, but argues that these missing teachings are provided by Weber. Applicants respectfully disagree.

The Examiner specifically relies on the teachings of Weber in column 4, lines 4-16, and in the corresponding figure, FIG. 2. Column 4, lines 4-16, of Weber provides as follows:

FIG. 2 illustrates a conceptual architecture of a multi-layer service management topology in accordance with a preferred embodiment of the present invention. The architecture for the system of the present invention is a traditional hierarchy of configurable items (CI's) with their associated interfaces. The architecture desirably is designed to support a hierarchical business structure wherein a primary core network is managed by a central global network operator and a number of distributors. In a preferred embodiment, a system management domain (SMD) 210, which desirably is under the control of a global network operator, is associated with core network 230, which desirably provides global connectivity.

Applicants have reviewed the relied-upon portions of Weber carefully, and have been unable to locate therein any teaching or suggestion regarding an inter-domain tree manager comprising a logical tree manager, with the logical tree manager being operative to manage a transport service and facility hierarchy associated with a multi-layer network, and to maintain corresponding parent-child relationships in one or more tree structures that reference domains containing real-time network details associated with the transport service and facility hierarchy, as recited in claim 1.

Claim 1 thus includes one or more limitations which are not taught or suggested by the proposed combination of Mortensen and Weber. The combined teachings of these references therefore fail to "teach or suggest all the claim limitations" as would be required by a proper §103(a) rejection.

Also, as indicated previously, the Examiner has failed to identify a cogent motivation for combining the references or for modifying the reference teachings to reach the claimed invention. On this point, the Examiner provides the following statement at page 3, last two lines, to page 4, lines 1-2, of the Office Action, with emphasis supplied:

At the time the invention was made, one of ordinary skill in the art would have been motivated to employ an inter-domain tree manager in order to provide hierarchical structure between the domains, therefore allowing quick retrieval of information associated with the network.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination “must be based on objective evidence of record” and that “this precedent has been reinforced in myriad decisions, and cannot be dispensed with.” In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that “conclusory statements” by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved “on subjective belief and unknown authority.” Id. at 1343-1344. There has been no showing in the present §103(a) rejection of objective evidence of record that would motivate one skilled in the art to combine Mortensen and Weber, or to modify the proposed combination, to produce the particular limitations in question. The above-quoted statement of obviousness given by the Examiner in the Office Action is precisely the type of subjective, conclusory statement that the Federal circuit has indicated provides insufficient support for an obviousness rejection. It therefore appears that the combination proffered by the Examiner is based primarily upon impermissible hindsight, given the benefit of the disclosure provided by Applicants, rather than upon any objective evidence of record.

Further, even if it is assumed that a proper *prima facie* case has been established, there are particular teachings in one or more of the references which controvert the obviousness argument put forth by the Examiner. For example, each of the two references provides a distinct approach to network management. There is no indication that these two distinct approaches are combinable into a single workable implementation in the manner alleged by the Examiner. To the contrary, the references themselves suggest that the proposed combination would likely be unworkable. See, for example, the Mortensen reference at page 7, middle of the page, wherein it is stated that a single network service manager approach, similar to that shown in FIGS. 2 and 3 of Weber, can be “close to impossible to implement . . . in the case of a large network.” Such teachings argue against the proposed combination, and teach away from the claimed invention.

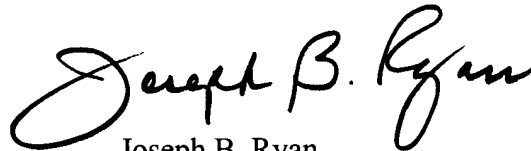
Applicants therefore respectfully submit that independent claim 1 is allowable over Mortensen and Weber.

Dependent claims 2-17 are believed allowable for at least the reasons identified above with regard to independent claim 1. One or more of these claims are also believed to define additional separately-patentable subject matter relative to the proposed combination of Mortensen and Weber.

Independent claims 18 and 19 include limitations similar to those of claim 1, and are believed allowable for substantially the same reasons identified above with regard to claim 1.

Accordingly, it is believed that claims 1-19 are in condition for allowance, and such favorable action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, reading "Joseph B. Ryan". The signature is fluid and cursive, with the first name "Joseph" and last name "Ryan" clearly legible.

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